

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MINNESOTA**

FANTESCA ESTATE & WINERY, LLC,

Plaintiff,

V.

DAL-TILE CORPORATION,

Defendant.

CIVIL ACTION NO.

JURY TRIAL DEMANDED

COMPLAINT

Plaintiff Fantesca Estate & Winery, LLC (“Fantesca Winery”) for its Complaint against Defendant Dal-Tile Corporation (“Dal-Tile”), states and alleges as follows:

NATURE OF THIS ACTION

1. Fantesca Winery operates a nationally recognized Napa Valley vineyard, and sells high quality estate wines under its federally registered FANTESCA® trademarks. Dal-Tile claims to be one of the world's largest manufacturers of ceramic tile and recently began using the designation FANTESCA™ to advertise and promote a line of wine-themed tile products. Dal-Tile has persisted in its infringing sales despite full knowledge of Fantesca Winery's federal trademark registrations and despite requests that Dal-Tile cease its infringement of the FANTESCA® marks. In the face of Dal-Tile's willful infringement, Fantesca Winery brings this action for trademark infringement, unfair competition, and violation of Minnesota's Deceptive Trade Practices Act. Fantesca Winery seeks an award of damages caused by Dal-Tile's infringing conduct, disgorgement of Dal-Tile's profits earned through infringement, and

an injunction prohibiting Dal-Tile from further and continued infringement of Fantesca Winery's trademark rights.

PARTIES

2. Fantesca Winery is a Minnesota limited liability company with a registered business address located at 8500 Normandale Lake Blvd. Suite 1750, Minneapolis, MN 55437. Fantesca Winery operates a nationally recognized vineyard and winery located in Napa Valley, California. Fantesca Winery sells a variety of wines, in this District and throughout the United States, under its federally registered FANTESCA® trademarks.

3. Defendant Dal-Tile Corporation is a Delaware corporation with a principal place of business located at 7834 Hawn Freeway, Dallas, TX 75217. Dal-Tile Corporation manufactures and sells the wine-themed tile products sold under the designation FANTESCA at issue in this case.

NATURE OF THIS ACTION; JURISDICTION OF THE COURT

4. This Court has jurisdiction over the subject matter of this action under 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331 and 1338 (a) and (b), and has supplemental jurisdiction under 28 U.S.C. § 1367(a) over Fantesca Winery's claims under state law.

5. The matter in controversy in this action exceeds the sum or value of \$75,000, exclusive of interest and costs, and is between citizens of different states. Accordingly, this Court also has subject matter jurisdiction pursuant to 28 U.S.C. § 1332.

6. This Court has personal jurisdiction over Dal-Tile under Minn. Stat. § 543.19. Dal-Tile knowingly directed its unlawful actions toward this district and other districts throughout the United States. On information and belief, Dal-Tile purposefully established continuous and systematic contacts with residents of this district, *inter alia*, by offering its wine-

themed tiles for sale through retailers in Minnesota.

7. The exercise of personal jurisdiction over Dal-Tile by the Court is proper under the Due Process Clause of the U.S. Constitution, and other applicable laws.

FANTESCA AND ITS MARKS

8. Since at least 2004, Fantesca Winery has continuously used the FANTESCA® marks in interstate commerce in connection with the advertising, promotion, and sale of its vineyard, winery, wine, and related products and services.

9. Fantesca Winery has registered the FANTESCA® marks on the Principal Register of the United States Patent and Trademark Office, including U.S. Registration Nos. 3,144,638, 3,066,044, 3,026,336, and 3,572,928. True and correct copies of these registrations are attached hereto as Exhibits A-D.

10. All of these registrations are valid, subsisting and enforceable.

11. U.S. Registration Nos. 3,144,638, 3,066,044, and 3,026,336, are incontestable pursuant to 15 U.S.C. § 1065.

12. As is common in the sale of wines and wine-related products, Fantesca Winery regularly uses its FANTESCA® marks in association with specific wine varietals, such as FANTESCA® CHARDONNAY.

13. Fantesca Winery's wines sold under the FANTESCA® marks have been widely recognized for their high quality, and have received accolades from national publications such as *Wine Enthusiast* and *Wine & Spirits*.

14. Fantesca Winery has expended substantial amounts advertising and promoting its wine, and related products and services sold in association with the FANTESCA® marks.

Through its substantial expenditures and efforts, Fantesca Winery's FANTESCA® marks have become widely recognized in the United States among actual and potential purchasers of the Fantesca Winery's products and services.

15. Fantesca Winery sells its genuine FANTESCA® wines through a variety of retail outlets, including through on-line ordering over the Internet. In fact, Fantesca Winery has registered the FANTESCA® mark specifically for “retail stores and online ordering services featuring wine.”

DAL-TILE AND ITS ACTIVITIES

16. Beginning sometime in 2011, Dal-Tile began using the designation FANTESCA™ to advertise and promote a line of wine-themed tile products. A true and correct copy of Dal-Tile's press release announcing the release of this product line is attached hereto as Exhibit E.

17. Like Fantesca Winery's genuine FANTESCA® wines, Dal-Tile uses the FANTESCA designation in association with the name of specific wine varietals, such as FANTESCA CHARDONNAY.

18. Dal-Tile advertises and promotes its infringing wine-themed tile products through a variety of promotional materials, including sample boards which prominently display the FANTESCA designation in large font size adjacent to the superscripted identifier “tm.”

19. By use of the superscripted identifier “tm,” Dal-Tile purports to give notice that it claims trademark rights in the designation FANTESCA.

20. Dal-Tile offers the Fantesca wine-themed tile products for sale through a variety of retail outlets, many of which advertise extensively over the Internet.

21. A search on a popular search engine GOOGLE of the term FANTESCA triggers organic first page search results that all relate directly to Fantesca Winery and its genuine products sold under the FANTESCA® marks, with the exception of one result for Dal-Tile's infringing wine-themed tile products. Similarly, the "suggested" search terms directly relate to Fantesca Winery and its genuine FANTESCA® products. A true and correct copy of an example of such organic search results is attached hereto as Exhibit F.

22. Dal-Tile did not ask for or obtain Fantesca Winery's permission to use the FANTESCA® marks on or in connection with the promotion or sale of its wine-themed tile products.

23. Upon learning of Dal-Tile unauthorized use of the FANTESCA® marks, Fantesca Winery requested that Dal-Tile cease its infringing conduct. A true and correct copy of Fantesca Winery's written request is attached as Exhibit G.

24. Despite this request and with full knowledge of the Fantesca Winery's prior and incontestable rights in the FANTESCA® marks, Dal-Tile has persisted in its infringing conduct in the District and throughout the United States.

25. Dal-Tile's unauthorized use of the FANTESCA® marks in the manner described above is likely to cause confusion, to cause mistake, and/or to deceive consumers as to the source, sponsorship or affiliation of the parties' goods products sold under the FANTESCA® marks.

26. Dal-Tile's unauthorized use of the FANTESCA® marks in the manner described above enables Dal-Tile to trade on and receive the benefit of goodwill in those marks, which Fantesca Winery has built up at great labor and expense. Dal-Tile's unauthorized use also

enables it to gain acceptance for its new wine-themed tiles, not solely on its own merits, but on the reputation and goodwill of Fantesca Winery and the FANTESCA® marks.

27. Dal-Tile's use of the FANTESCA® marks in the manner described above unjustly enriches Dal-Tile at Fantesca Winery's expense.

28. Dal-Tile's unauthorized use of the FANTESCA® marks in the manner described above deprives Fantesca Winery of the ability to control the nature and quality of products provided under those marks, and places the valuable reputation and goodwill of Fantesca Winery in the hands of Dal-Tile, over whom Fantesca Winery has no control.

29. Dal-Tile's activities have caused irreparable injury to Fantesca Winery, its goodwill and its customer relationships and, unless restrained by this Court, will continue to cause irreparable injury to Fantesca Winery and to the public. There is no adequate remedy at law for this injury.

30. Dal-Tile's actions complained of herein have been deliberate, willful, malicious and in bad faith, with the intent to mislead consumers and inflict injury on Fantesca Winery. This is an exceptional case under 15 U.S.C. § 1117(a).

COUNT I

FEDERAL TRADEMARK INFRINGEMENT

31. Fantesca Winery repeats the allegations above as if fully set forth herein.

32. The acts of Dal-Tile complained of herein constitute infringement of Fantesca Winery's federally registered FANTESCA® marks in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114(1).

33. Dal-Tile's infringement has been willful and in bad faith, making this an exceptional case under 15 U.S.C. § 1117(a).

34. As a result of Dal-Tile's wrongful conduct, Fantesca Winery is entitled to the preliminary and permanent injunctive remedies specified in the Prayer for Relief, damages in an amount to be proven at trial, and recovery of all reasonable attorneys' fees and costs incurred herein.

COUNT II

FEDERAL UNFAIR COMPETITION

35. Fantesca Winery repeats the allegations above as if fully set forth herein.

36. The acts of Dal-Tile complained of herein constitute unfair competition in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

37. Dal-Tile's unfair competition has been willful and in bad faith, making this an exceptional case under 15 U.S.C. § 1117(a).

38. As a result of Dal-Tile's wrongful conduct, Fantesca Winery is entitled to the preliminary and permanent injunctive remedies specified in the Prayer for Relief, damages in an amount to be proven at trial, and recovery of all reasonable attorneys' fees and costs incurred herein.

COUNT III

VIOLATION OF THE MINNESOTA DECEPTIVE TRADE PRACTICES ACT

39. Fantesca Winery repeats the allegations above as if fully set forth herein.

40. The acts of Dal-Tile complained of herein constitute deceptive trade practices in violation of the Minnesota Deceptive Trade Practices Act, Minnesota Statutes Section 325D.44, *et seq.*

41. As a result of Dal-Tile's wrongful conduct, Fantesca Winery is entitled to the preliminary and permanent injunctive remedies specified in the Prayer for Relief, damages in an amount to be proven at trial, and recovery of all reasonable attorneys' fees and costs incurred herein.

COUNT IV

COMMON LAW TRADEMARK INFRINGEMENT

42. Fantesca Winery repeats the allegations above as if fully set forth herein.

43. The acts of Dal-Tile complained of herein constitute trademark infringement in violation of the common law of Minnesota and other states where Dal-Tile is conducting their activities.

44. As a result of Dal-Tile's wrongful conduct, Fantesca Winery is entitled to the preliminary and permanent injunctive remedies specified in the Prayer for Relief, damages in an amount to be proven at trial, and recovery of all reasonable attorneys' fees and costs incurred herein.

COUNT V

COMMON LAW UNFAIR COMPETITION

45. Fantesca Winery repeats the allegations above as if fully set forth herein.

46. The acts of Dal-Tile complained of herein constitute unfair competition in violation of the common law of Minnesota and other states where Dal-Tile is conducting its activities.

47. As a result of Dal-Tile's wrongful conduct, Fantesca Winery is entitled to the preliminary and permanent injunctive remedies specified in the Prayer for Relief, damages in an amount to be proven at trial, and recovery of all reasonable attorneys' fees and costs incurred herein.

COUNT VI

UNJUST ENRICHMENT

48. Fantesca repeats the allegations above as if fully set forth herein.

49. The acts of Dal-Tile complained of herein constitute unjust enrichment of Dal-Tile at the expense of Fantesca.

50. As a result of Dal-Tile's wrongful conduct, Fantesca Winery is entitled to the preliminary and permanent injunctive remedies specified in the Prayer for Relief, damages in an amount to be proven at trial, and recovery of all reasonable attorneys' fees and costs incurred herein.

PRAYER FOR RELIEF

WHEREFORE, Fantesca Winery prays that:

- (a) Dal-Tile, its officers, agents, servants, employees, attorneys, and all those persons in active concert or participation with them, be preliminarily and permanently enjoined and restrained from using, the FANTESCA® marks, and any other

mark, trade name, or corporate name that is confusingly similar to the FANTESCA® marks;

- (b) Dal-Tile be ordered to file with this Court and to serve upon Fantesca Winery within thirty (30) days after the entry and service on Dal-tile of an injunction, a report in writing and under oath setting forth in detail the manner and form in which Dal-Tile has complied with the injunction;
- (c) Fantesca Winery recover all damages it has sustained as a result of Dal-Tile's activities and that said damages be trebled;
- (d) An accounting be directed to determine Dal-Tile's profits resulting from the activities complained of herein, and that such profits be paid over to Fantesca Winery, increased as the Court finds to be just under the circumstances of this case;
- (e) Fantesca Winery recover its reasonable attorney fees;
- (f) Fantesca Winery recover its costs of this action and prejudgment and post-judgment interest; and
- (g) Fantesca Winery recover such other relief as the Court may deem just and equitable.

DATED: December 3, 2012

ROBINS, KAPLAN, MILLER & CIRESI L.L.P.

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